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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/550,960	04/17/2000	Richard C. Levine	065581.0105	1648

7590 12/02/2002
Baker Botts LLP
2001 Ross Avenue
Dallas, TX 75201

EXAMINER

GEHMAN, BRYON P

ART UNIT PAPER NUMBER

3629

DATE MAILED: 12/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/550,960

Applicant(s)

LEVINE, RICHARD C.

Examiner

Bryon P. G hman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-154 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-154 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-154 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

Claims 117-119 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 117, lines 1-2, "the data base" lacks antecedent basis.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 77-127 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to abstract ideas and, therefore, non-statutory subject matter. As the method does not involve any computer or structural means to carry out any functions. The present claims clearly are not directed to machines, manufactures or compositions of matter. The Supreme Court in *Diamond v. Diehr*, 450 U.S. 175, 184, 209 USPQ 1, 6 (1981) explained:

In defining the nature of a patentable process, the Court stated:

That a process may be patentable, irrespective of the particular form of instrumentalities used, cannot be disputed. * * * A process

is a mode of treatment of certain materials to produce a given result.

It is an act, or a series of acts, performed upon the subject matter to be transformed and reduced to a different state or thing. . . . The process requires that certain things should be done with certain substances, and in a certain order; but the tools to be used in doing this may be of secondary consequence. Cochrane v. Deener, 94 U. S. 780, 787-788 (1876).

The Court further referenced a definition of "process" given in Corning v. Burden, 15 How. 252, 267-268 (1853) wherein the Court stated:

The term machine includes every mechanical device or combination of mechanical powers and devices to perform some function and produce a certain effect or result. But where the result or effect is produced by chemical action, by the operation or application of some element or power of nature, or of one substance to another, such modes, methods or operations, are called processes. . . . It is when the term process is used to represent the means or method of producing a result that it is patentable, and it will include all methods or means which are not effected by mechanism or mechanical combinations.

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The claimed methods fail to meet the Court's definition of statutory process. Specifically, in the claimed methods of claims 77-127, there is no treatment of materials such that subject matter is transformed and reduced to a different state. There is no chemical action or operation or application of an element or power of nature; there is purely human intervention. Accordingly, the claimed methods are merely abstract ideas and not statutory processes. It is noted the claims are directed to a business method, which is no longer an exception to statutory subject matter. However, merely labeling the method "a business method" does not magically transform a process into a statutory one.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000.

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Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 6, 8, 10-11, 13-17, 23, 28-29, 39-46, 48-49, 51-55, 61, 66-67, 77-85, 88-94, 101, 104, 106-109, 128, 133-136, 139, and 144-145 are rejected under 35 U.S.C. 102(e) as being anticipated by Cordery et al. (6,466,921 B1). Disclosed is a method and system comprising obtaining, at a first point (location of PC 20), a first address (addressee or postal information, col. 5, line 53 through col. 6, line 12) and a first functional property code (authentication by username or password, col. 6, lines 21-27), storing, at a data base (the Data Center), a second functional property code (data base record of username or password), a second address (corresponding to data base record of the address) and a third address (sent back to the PC20), determining, at the data base, if the first address is compatible with the second address (determines the origin zip, see col. 6, lines 1-5), determining, at the data base, if the first functional property code is compatible with the second functional property code, and sending the third address (indicium information) to the first point if the codes are compatible (see col. 5, line 39 through col. 6, line 27).

As to claims 2-4, 40-42, 77-85 and 101, see col. 5, lines 21-37.

As to claims 6 and 44, the second address does not include the nine-digit ZIP code.

As to claims 8, 46, 108 and 135, the first address comprises part of the second address.

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As to claims 10-11, 48-49, 88-89, 106 and 133, the first point is an origin point, as the second point is a destination point.

As to claims 13 and 51, the data base (Data Center) is remote from the first point.

As to claims 14 and 52, the data base comprises a processor (32 and/or 34) and a memory (36).

As to claims 15, 53, 107 and 134, the first and second addresses match.

As to claims 17, 55, 109 and 136, the first and second property codes match.

As to claims 23, 28-29, 61, 66-67, 112, 139, and 144-145, disclosed are multiple PC systems, necessitating plural addresses and points (see col. 5, lines 19-37).

Claims 1, 6-8, 10-11, 13-14, 17-20, 28-29, 39, 43-46, 48-49, 51-52, 55-58 and 66-67, 77, 83-86, 88-93, 101-104, 106, 108-109, 112, 120-121, 128-129 and 136 are rejected under 35 U.S.C. 102(b) as being anticipated by Gravell et al. (5,943,658). Disclosed is a method and system comprising obtaining, at a first point (customer site 15 and postage meter), a first address (ZIP code) and a first functional property code (customer phone number), storing, at a data base (Vendor Data Center), a second functional property code (phone number in the Phone Book Database), a second address (record of five-digit ZIP code found in the ZIP+4 Database) and a third address (ZIP+4 in the ZIP+4 database) determining, at the data base, if the first address is compatible with the second address (see col. 5, lines 4-18), determining, at the data base, if the first functional property code is compatible with the second functional

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property code (see col. 4, lines 8-30), and sending the third address (new certificate, see col. 5, lines 4-39) to the first point (postage meter, see co. 3, lines 1-17) if the codes are compatible.

As to claims 6 and 44, the second address does not include the ZIP code (see col. 4, lines 20-30).

As to claims 8 and 46, the first address comprises part of the second address.

As to claims 10-11, 48-49, 88-89, 106, 133 the first point is an origin point, as the second point is a destination point.

As to claims 13 and 51, the data base (Vendor Data Center) is remote from the first point.

As to claims 14 and 52, the data base comprises a processor (22) and a memory (26 and 28).

As to claims 17, 55, 109 and 136, the first and second property codes match.

As to claims 18-20 and 56-58, the host PC stores the first functional property of the modem phone number and employing different phone numbers.

As to claims 28-29 and 66-67, a Phone Book database indicates plural second points.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 9, 24, 26-27, 31-38, 47, 54, 62, 64-65, 69-70, 72-75, 87, 97-99, 105, 113, 115-119, 123-126, 130-132, 140, 142-143 and 147-153 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Cordery et al. and Gravell et al. Although not specifically described or disclosed, the features of the claims rejected hereunder pertain to differences from the disclosures of Cordery et al. and Gravell et al. that would fall within the level of ordinary skill in the art.

As to claim 5, the retrieving of a mailed object would appear to be expected, as mail is sent to be obtained or retrieved.

As to claims 9, 47, 87, 105, 132 to employ a pseudo-address would have been a matter of descriptive material. The differences are only found in the nonfunctional data stored in the data base. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability. See *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

Claims 12, 21-22, 25, 30, 38, 50, 59-60, 63, 68, 71, 76, 95, 96, 100, 110, 111, 114, 119, 122, 127, 137, 138, 141, 146 and 154 are rejected under 35 U.S.C. 103(a) as being unpatentable over either one of Cordery et al. and Gravell et al. in view of Gunn. Gunn discloses a data base co-located with a first point, a "no match" indication

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provided to a first point (see col. 6, lines 26-51) if the address does not match, as well as a parcel delivery network. To modify the system and method of either one of Cordery et al and Gravell et al. employing the teachings of Gunn with respect to a "no match" feature and a parcel system would have been obvious in order to facilitate use of the system for a particular content.

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: I) Figure 1; II) Figure 2; III) Figure 3; and IV) Figure 4.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is held generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

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are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.. Fougere et al. (4,743,747) disclose a method and system of applying an address to a label from a remote site. Whitehouse (5,341,505) disclose a method and system that enables access to a remote address database for addressing an object. Reiter (5,819,241) discloses a method and system that compares data to allow data to be applied to an object. Pierce et al. discloses a database storing address and code information for mailing an object. Reiter (6,178,411 B1) discloses a method and system that compares data to allow data to be applied to an object. Shah et al. (6,240,403 B1) discloses a method and system that acts to print addresses obtained from a remote site and encrypting the addresses. Thorn EMI (UK 2193160 A) discloses a system and method of applying an address to mail including a coded address. "The

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Electronic Mailcenter" discloses a system including address verification and storage in a database.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiner. As the official records and applications are located in the clerical section of the examining Tech Center, the clerical personnel can readily provide status information without contacting the examiner. See MPEP 203.08. The Tech Center clerical receptionist number is (703) 308-1113.

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.


Any inquiry concerning the merits of the examination of the application should be directed to Bryon Gehman at telephone number (703) 308-3866. My work schedule is normally Tuesday through Friday from 6:30 am through 4 pm.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 305-7687 and (703) 305-3597. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

Other possibly helpful telephone numbers are:

Allowed Files & Publication	(703) 305-8322
Assignment Branch	(703) 308-9287
Certificates of Correction	(703) 305-8309
Drawing Corrections/Draftsman	(703) 305-8404/ 8335
Fee Questions	(703) 305-5125
Intellectual Property Questions	(703) 305-8217
Petitions/Special Programs	(703) 305-9282
Terminal Disclaimers	(703) 305-8408
Information Help Line	1-800-786-9199

BPG
November 26, 2002



Bryon P. Gehman
Primary Examiner